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JORDAN AND HAMBURG LLP 122 EAST 42ND STREET SUITE 4000 NEW YORK, NY 10168				EXAMINER MCQUELLAND, KIMBERLY KEIL
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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/736,185	SUGINO, NOBUO
	Examiner Kimberly K. McClelland	Art Unit 1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 20 June 2006.  
 2a) This action is FINAL.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-8, 10, 11 and 13-38 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-8, 10-11, 13-38 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 27-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The phrase, "at least" in lines 2-3 is not supported in the specification in reference to the list of possible adhesives. "At least" implies using multiple adhesives and there is no disclosure of using multiple adhesives from the given list.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 4, 5, 10-11 and 27-28 are rejected under 35 U.S.C. 102(b) as anticipated by Brault et al. (US Patent No. 5,601,959).

Brault discloses a transfer method comprising the steps of (Figures 1-12; column 4, line 38 to column 9, line 63):

5. Providing a transfer sheet comprising a carrier (24) and transferable overcoating layer (26) (column 4, lines 20-35);
6. Providing a pattern (18) onto the upper surface of the transfer sheet by electrophotographic printing (column 4, lines 38-62);
7. Applying an adhesive (22) onto the image (18) disposed on the surface of the transfer sheet (24, 26) (column 5, line 41 to column 6, line 17);
8. Contacting under the effects of pressure and/or heat, the adhesive coated transfer sheet (24, 26, 18, 22) with a target substrate (20) to bond and transfer the image (18) onto the substrate (20) via the adhesive layer (22) (column 6, lines 27-63); and
9. Stripping or peeling the carrier (24) of the transfer sheet (24, 26) from the image (18) adhesively bonded to the substrate (20) (column 6, lines 64-68).

Regarding applicant claim 1, Brault discloses the adhesive may comprise a pressure-sensitive, such as 3M Scotch Brand Spray Mount (a transparent adhesive), heat activated adhesives such as those based on thermoplastic polyurethane, polycaprolactone, and acrylic copolymers (column 5, lines 41 to column 6, line 26). While there is no specific mentioning of the surface tension of the adhesive, it is appreciated that these types of adhesives by their very nature would have a surface tension where it moves smoothly on the upper surface of the pattern.

As to claim 2, the adhesive used in Brault is capable of being colored by paint.

Regarding applicant claims 4, 5, 10, and 11, Brault discloses that the transfer sheet (24, 26) may utilize a release layer ("remover layer") (30) disposed over the carrier sheet by coating (column 8, lines 55-59).

Regarding claims 27-28, Brault discloses the adhesive may comprise a pressure-sensitive, such as 3M Scotch Brand Spray Mount (a transparent adhesive), heat activated adhesives such as those based on thermoplastic polyurethane, polycaprolactone, and acrylic copolymers (column 5, lines 41 to column 6, line 26).

10. Claims 1 and 13 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by U.S. Patent No. 5,306,374 to Hambright.

11. As to claim 1, Hambright discloses a transfer method, including applying an adhesive to an upper surface of a pattern, the pattern having been formed on a transfer sheet by copying or printing, the adhesive having a surface tension such that the adhesive moves smoothly on the upper surface the pattern, the adhesive being one of hot-melt adhesive, water soluble, or alcohol soluble adhesive; and transferring the pattern to a substrate by applying pressure or heat wherein one or more patterns can be transferred on a substrate and wherein the patterns are adapted to be able to overlay on one another on the substrate (See Figures 1-10, and column 3, line 55-column 4, line 55).

12. As to claim 13, Hambright discloses applying an adhesive with a brush to an upper surface of a pattern, the pattern having been formed on a transfer sheet by copying or printing; and transferring the pattern to a substrate by applying heat or pressure (See Figures 1-10, and column 3, line 55-column 4, line 55).

13. As to claim 29, Hambright discloses the adhesive is applied to an upper surface of the pattern before the transferring of the pattern to the substrate, and the adhesive which has already been applied to the upper surface of the pattern is directly contacted with the substrate to thereby obtain the transferring of the pattern to the substrate (See Figures 1-10, and column 3, line 55-column 4, line 55).

14. As to claim 30, Hambright discloses the substrate is free of adhesive before the pattern is transferred to the substrate (26; See Figure 5).

15. As to claim 36, Hambright discloses applying the pattern to the substrate and subsequently separating the transfer sheet from the pattern (See Figure 10).

#### ***Claim Rejections - 35 USC § 103***

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brault as applied to claim 1 above, and further in view of Oldfield (US Patent No. 5,332,713).

Brault discloses a transfer method wherein the transfer sheet includes an intermediate layer (26) between the release layer (30) and the image layer (18) which, upon transfer, remains attached in an overlaying relationship to the image layer (18) adhered to the substrate (20) by adhesive layer (22). Brault further discloses that the

intermediate layer (26) is transparent and protects the image (18) from abrasion, fading, chemical degradation or damage (column 9, lines 13-20).

Oldfield discloses forming with a brush one or more coating layers on the transferred pattern after the transfer step is carried out as prior art (column 1, lines 59-69). It is inherent that the coating layer would either be transparent or colored. It would have been obvious to one of ordinary skill in the art to combine the prior art coating method taught by Oldfield with the transfer method disclosed by Brault and Edwards. The motivation would have been to protect the transferred pattern (column 1, lines 59-69).

18. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brault in view of Fukushima et al. (US Patent No. 3,716,360).

As set forth above in paragraph 7, Brault discloses forming a transfer sheet (24) with a pattern (18) formed on a release or remover layer (30). The pattern is transferred to another substrate using heat and pressure. While Brault does not specifically state the adhesive is transparent or semi-transparent, it is appreciated that in order for the indicia (18) to be seen in the final product, the adhesive must be either transparent or semi-transparent. While Brault discloses using heat and pressure to effect the transfer, Brault does not teach using the heat of an iron as required by claim 7. It would have been obvious to one having ordinary skill in the art at the time the invention was made that an iron is a well known method of heating and applying pressure to achieve the transfer in the method of Brault, this is shown for example in Fukushima where an

electric iron is one alternative to soften the image to assist in the transfer operation.

(Col. 3, lines 18-40.)

19. Claims 13, 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brault in view of Edwards (US Patent No. 3,334,003).

Regarding claim 13, as set forth above in paragraph 7, Brault discloses forming a transfer sheet (24) with a pattern (18) having an adhesive (22) applied onto the pattern (18). Brault specifically teaches that one type of adhesive can be a spray mount adhesive, but there is no specific teaching that brushing the adhesive on is an alternative. Edwards demonstrates that an obvious alternative to using a spray mount adhesive is to brush the adhesive onto the surface bearing the indicia to be transferred. It would have been obvious to one having ordinary skill in the art at the time the invention was made to brush the adhesive used in Brault, because Edwards teaches that spraying and brushing are functionally equivalent alternative expedient, both of which are known in the art.

Regarding claim 15, it is appreciated to an artisan, that an adhesive would have surface tension greater than that of water.

Regarding claim 16, because a brush is being used to spread the adhesive in Brault in view of Edwards, the artisan would appreciate that the adhesive must have a surface tension which enables it to be spread.

Regarding claim 17, Brault discloses that the transfer sheet (24, 26) may utilize a release layer ("remover layer") (30) disposed over the carrier sheet.

20. As to claim 31, Brault also discloses that the transfer sheet (24, 26) may utilize a release layer ("remover layer") (30) disposed over the carrier sheet (See Figures 7-8).
21. As to claim 32, Brault also discloses that the transfer sheet (24, 26) may utilize a release layer ("remover layer") (30) disposed over the carrier sheet by coating (column 8, lines 55-59). Brault does not specifically disclose the remover layer is formed by spraying. However, Brault discloses spraying the adhesive layer onto the transfer sheet (column 10, lines 56-60). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the spraying technique taught by Brault with the remover layer on the transfer sheet. The motivation would have been to evenly coat the base transfer sheet.
22. As to claim 33, Brault discloses the pattern comprises one or more separate designs printed or copied onto one transfer sheet, and one or more designs are transferred sequentially to the substrate (Figures 1-12; column 4, line 38 to column 9, line 63).
23. As to claim 34, Brault discloses copying or printing is done with a resin toner (column 10, lines 10-14),
24. As to claim 35, Brault discloses one or more coating layers are applied as a liquid (column 8, lines 55-56).
25. As to claim 36, Brault discloses applying the pattern to the substrate and subsequently separating the transfer sheet from the pattern (See Figure 11).

26. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brault in view of Edwards as applied to claim 13 above, further in view of Fukushima et al.

As set forth above in paragraphs 7 and 11 above, Brault discloses forming a transfer sheet (24) with a pattern (18). The pattern is transferred to another substrate using heat and pressure. While Brault discloses using heat and pressure to effect the transfer, Brault does not teach using the heat of an iron as required by claim 14. It would have been obvious to one having ordinary skill in the art at the time the invention was made that an iron is a well known method of heating and applying pressure to achieve the transfer in the method of Brault in view of Edwards, this is shown for example in Fukushima where an electric iron is one alternative to soften the image to assist in the transfer operation. (Col. 3, lines 18-40.)

27. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brault in view of Edwards as applied to claim 13 above, and further in view of Sandor.

There is no discussion in Brault or Edwards of over-transferring, which is defined in applicant's specification as transferring an image onto another image. Sandor shows multiple images being transferred in Figure 2. It would have been obvious to one having ordinary skill in the art at the time the invention was made that transferring an image on top of another image to achieve a desire effect of layered images, as shown in Sandor.

28. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brault in view of Edwards as applied to claim 13 above, and further in view of Takahara et al. (US Patent No. 5,589,434).

Brault in view of Edwards does not discuss adding coloring to the adhesive. It would have been obvious to one having ordinary skill in the art at the time the invention was made to add a white paint or some other kind of coloring to the adhesive in Brault in view of Edwards, because one of ordinary skill in the art would appreciate that using paint in the adhesive can result in changing the resulting image which ends up being viewed. Furthermore, Takahara teaches adding paint to the adhesive can result in improving whiteness and preventing background color of an image receiving sheet from affecting the resultant image. (Col. 18, lines 57-67)

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brault in view of Edwards and Takahara et al (US Patent No. 5,589,434) as applied to claims 19 and 20 above, and further in view of Damico et al (US Patent No. 2003/0121606).

Regarding claim 22, Damico discloses it is well-known in the art to mix/apply adhesive with a paint brush (See paragraph 0041). It would have been obvious to one of ordinary skill in the art to use a conventional method of mixing/applying adhesive, such as using a paint brush as taught by Damico et al. The motivation would have been to effectively mix the adhesive.

29. Claims 21 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brault in view of Edwards as applied to claim 13 above, and further in view of Sandor.

Brault in view of Edwards does not specifically disclose, as per applicant claim 21, that such a protective layer is applied over the transferred image after the transfer step has been carried out, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the protective layer of Brault in view of Edwards either simultaneously with transfer or as a subsequent step following transfer motivated by the fact that Sandor, also drawn to method for the adhesive transfer of electrophotographic images from a transfer sheet to a target substrate (abstract), discloses that following transfer, the image can be overcoated with a layer of clear, durable seal coat resin, i.e., a varnish (column 7, lines 19-22., column 10, lines 40-50).

30. Claims 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brault in view of Edwards as applied to claim 13 above, and further in view of U.S. Patent No. 6,582,803 to Cole.

31. Regarding claim 23, Brault in view of Edwards discloses slitting the transfer sheet (Brault; column 10, lines 9-10). However, Brault in view of Edwards does not specifically disclose cutting a portion of the transfer sheet with a pair of scissors, said cutting being done before the pattern is transferred to the substrate.

32. Cole discloses a transfer sheet, including cutting a portion of the transfer sheet with a pair of scissors, said cutting being done before the pattern is transferred to the substrate (column 5, lines 5-9). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the cutting means disclosed by Cole in the transfer method disclosed by Brault in view of Edwards. The motivation would have been to transfer only a portion an image to a substrate (Cole, column 5,

lines 5-6). Therefore, it would have been obvious to combine Cole with Brault and Edwards to obtain the invention as disclosed in claim 23.

33. As to claim 24, Brault in view of Edwards discloses the portion of the transfer sheet includes that pattern to be transferred (column 10, lines 9-13).

34. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brault in view of Edwards as applied to claim 13 above, and further in view of Sandor, Cole, Takahara et al (US Patent No. 5,589,434), Damico et al (US Patent No. 2003/0121606), and U.S. Patent No. 5,332,713 to Oldfield.

35. As set forth above in paragraph 7, Brault discloses forming a transfer sheet (24) with a pattern (18) having an adhesive (22) applied onto the pattern (18). Brault specifically teaches that one type of adhesive can be a spray mount adhesive, but there is no specific teaching that brushing the adhesive on is an alternative. Edwards demonstrates that an obvious alternative to using a spray mount adhesive is to brush the adhesive onto the surface bearing the indicia to be transferred. It would have been obvious to one having ordinary skill in the art at the time the invention was made to brush the adhesive used in Brault, because Edwards teaches that spraying and brushing are functionally equivalent alternative expedient, both of which are known in the art.

36. Brault in view of Edwards does not discuss adding coloring to the adhesive. It would have been obvious to one having ordinary skill in the art at the time the invention was made to add a white paint or some other kind of coloring to the adhesive in Brault in view of Edwards, because one of ordinary skill in the art would appreciate that using

paint in the adhesive can result in changing the resulting image which ends up being viewed. Furthermore, Takahara teaches adding paint to the adhesive can result in improving whiteness and preventing background color of an image receiving sheet from affecting the resultant image. (Col. 18, lines 57-67)

37. Damico discloses it is well-known in the art to mix/apply adhesive with a paint brush (See paragraph 0041). It would have been obvious to one of ordinary skill in the art to use a conventional method of mixing/applying adhesive, such as using a paint brush as taught by Damico et al. The motivation would have been to effectively mix the adhesive.

38. There is no discussion in Brault or Edwards of over-transferring, which is defined in applicant's specification as transferring an image onto another image. Sandor shows multiple images being transferred in Figure 2. It would have been obvious to one having ordinary skill in the art at the time the invention was made that transferring an image on top of another image to achieve a desire effect of layered images, as shown in Sandor.

39. Cole discloses a transfer sheet, including cutting a portion of the transfer sheet with a pair of scissors, said cutting being done before the pattern is transferred to the substrate (column 5, lines 5-9). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the cutting means disclosed by Cole in the transfer method disclosed by Brault in view of Edwards. The motivation would have been to transfer only a portion an image to a substrate (Cole, column 5, lines 5-6).

40. Oldfield discloses forming with a brush one or more coating layers on the transferred pattern after the transfer step is carried out as prior art (column 1, lines 59-69). It would have been obvious to one of ordinary skill in the art to combine the prior art coating method taught by Oldfield with the transfer method disclosed by Brault and Edwards. The motivation would have been to protect the transferred pattern (column 1, lines 59-69).

41. Cole also discloses the heat is applied by an iron (column 3, lines 4-6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the hand-ironing step taught by Cole with the transfer method of Brault in view of Edwards. The motivation would have been to effectively transfer the pattern from the transfer sheet to the substrate (Cole, column 3, lines 4-6).

42. Brault discloses the surface tension of the upper surface of the pattern is thermoplastic polyurethane, polycaprolactone, and acrylic copolymers (column 5, lines 41-column 6, line 26). While there is no specific mentioning of the surface tension of the adhesive, it is appreciated that these types of adhesives by their very nature would have a surface tension where it moves smoothly on the upper surface of the pattern.

43. Brault also discloses that the transfer sheet (24, 26) may utilize a release layer ("remover layer") (30) disposed over the carrier sheet by coating (column 8, lines 55-59). Brault does not specifically disclose the remover layer is formed by spraying. However, Brault discloses spraying the adhesive layer onto the transfer sheet (column 10, lines 56-60). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the spraying technique taught by Brault with the

remover layer on the transfer sheet. The motivation would have been to evenly coat the base transfer sheet.

44. Brault discloses copying or printing is done with a resin toner (column 10, lines 10-14), and pressure sensitive vinyl adhesive (column 13, lines 6-9).

45. Claims 37-38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hambright in view of Oldfield.

46. As to claim 37, Hambright discloses forming a pattern on a transfer sheet by copying or printing; applying adhesive with a brush to a first surface on the pattern, said first surface of the pattern facing away from the transfer sheet; transferring the pattern to the substrate by applying heat or pressure, said transferring consisting of applying the pattern to the substrate to adhere the pattern to the substrate with the adhesive and subsequently separating the transfer sheet from the pattern (See Figures 1-10, and column 3, line 55-column 4, line 55). However, Hambright does not disclose forming one or more coating layers on the pattern after separating the transfer sheet from the pattern.

47. Oldfield discloses forming with a brush one or more coating layers on the transferred pattern after the transfer step is carried out as prior art (column 1, lines 59-69). It would have been obvious to one of ordinary skill in the art to combine the prior art coating method taught by Oldfield with the transfer method disclosed by Hambright. The motivation would have been to protect the transferred pattern (column 1, lines 59-69).

48. As to claim 38, Hambright discloses the transfer sheet consists of a liner sheet (38) and a remover layer (34; See Figure 8).

***Response to Arguments***

49. Applicant is reminded they need to explicitly point out where support for all the newly claimed features comes from as required by MPEP 5714.02 and j2163.06. See 37 CFR 1.111.

50. Applicant's arguments filed 20 June 2006 have been fully considered but they are not persuasive.

51. Regarding applicant's arguments that Brault cannot anticipate claim 1, because the adhesive in Brault does not have a surface tension such that it moves smoothly on the paper, the examiner disagrees with this position. Since the adhesive used in Brault is the same type used by applicant, it stands to reason, the adhesive would have the same property. While, Brault does not explicitly talk about the surface tension of the adhesive, it is implicit in the type of adhesive used and in the manner that Brault is using the adhesive. The express, implicit, and inherent disclosures of a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. 102 or 103. "The inherent teaching of a prior art reference, a question of fact, arises both in the context of anticipation and obviousness." *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995) (affirmed a 35 U.S.C. 103 rejection based in part on inherent disclosure in one of the references). See also *In re Grasselli*, 713 F.2d 731, 739, 218 USPQ 769,

775 (Fed. Cir. 1983). Surface tension, the ability to be colored, flexibility, straining properties, and overlayability are inherent substance properties. Therefore, if the adhesive used in the references is the same as that disclosed by applicant, then it is inherent that the surface tension would be the same.

52. There is no requirement that a person of ordinary skill in the art would have recognized the inherent disclosure at the time of invention, but only that the subject matter is in fact inherent in the prior art reference. *Schering Corp. v. Geneva Pharm. Inc.*, 339 F.3d 1373, 1377, 67 USPQ2d 1664, 1668 (Fed. Cir. 2003) (rejecting the contention that inherent anticipation requires recognition by a person of ordinary skill in the art before the critical date and allowing expert testimony with respect to post-critical date clinical trials to show inherency); see also *Toro Co. v. Deere & Co.*, 355 F.3d 1313, 1320, 69 USPQ2d 1584, 1590 (Fed. Cir. 2004) ("[T]he fact that a characteristic is a necessary feature or result of a prior-art embodiment (that is itself sufficiently described and enabled) is enough for inherent anticipation, even if that fact was unknown at the time of the prior invention."); *Abbott Labs v. Geneva Pharm. Inc.*, 182 F.3d 1315, 1319, 51 USPQ2d 1307, 1310 (Fed.Cir.1999).

53. Applicant's arguments drawn to claim 3 are moot in view of the new ground for rejection.

54. As to the arguments towards claims 7 and 8, applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091,

231 USPQ 375 (Fed. Cir. 1986). The iron of Fukushima is relied upon to demonstrate means of heating and pressing that are known to those of ordinary skill in the art.

55. As to applicant's argument that spraying and brushing are not functionally equivalent, examiner disagrees. One of ordinary skill in the art would recognize brushing an adhesive as an alternative to spraying an adhesive. Both are methods of coating well established in the art. Edwards clearly discloses that such functional equivalents are well-known and exercised.

56. As for the argument that Brault does not have the capability of transferring patterns such they can overlay each other, again the examiner disagrees. Brault is merely drawn to transferring print images, there is nothing in Brault which would lead one to deduce the pattern is not "able to overlay on another" as required by the claim.

57. Applicant is reminded that "[t]here are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of

ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). (See MPEP 2143.03.)

58. With respect to applicant's argument towards claim 17 that the adhesive layer does not slip off the remover layer, applicant is directed towards Brault, column 8, lines 25-35. Herein, Brault states the release layer may be used to ensure the adhesive is properly released from the substrate.

59. As to the argument the Fukushima does not teach using an iron to transfer a pattern to a substrate by adhering with an adhesive, examiner disagrees. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The iron of Fukushima is relied upon to demonstrate means of heating and pressing that are known to those of ordinary skill in the art.

60. As to claim 18, Applicant argues there is no motivation to perform over-transferring in the inventions of Brault. Examiner would like to point to paragraph 15 of the previous rejection, in which the last sentence clearly states the motivation as, "to achieve a desired effect of layered images." Consequently, examiner asserts sufficient motivation has been provided.

61. Applicant argues '131 discloses adding the paint to the substrate to which the adhesive is added, not the adhesive itself. Examiner agrees. The previous rejection is withdrawn, and a new rejection has been issued.

62. As to applicant's argument that there is no disclosure or suggestion of an adhesive being mixed with a brush. Examiner agrees. A new rejection has been issued.

63. With respect to applicant's argument towards claims 21 and 25, examiner disagrees. The language of the cited claims does not necessarily require direct intimate contact between the transferred pattern and coating layers. Furthermore, the dielectric layer may be considered a coating layer. Also, applicant argues there is no incentive to combine Brault and Sandor. However, one wishing to improve the protection of the pattern in Brault would look to Sandor's teaching of a protective coating. Such motivation has been provided in paragraph 17 of the previous rejection. As a result, the rejection is maintained.

64. New claims 27-38 have also been newly rejected.

### ***Conclusion***

65. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 5,039,745 to Riddle discloses paint as an aqueous mixture of pigment and an adhesive (column 3, lines 2-3).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly K. McClelland whose telephone number is (571) 272-2372. The examiner can normally be reached on 8:00 a.m.-5 p.m. Mon-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris A. Fiorilla can be reached on (571)272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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